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10/797,450	03/10/2004	Michael P. Remington JR.	1-16235	4442

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TOLEDO, OH 43604

EXAMINER

STOUFFER, KELLY M

ART UNIT	PAPER NUMBER
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1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/797,450

Applicant(s)

REMINGTON ET AL.

Examiner

Kelly Stouffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, filed 18 December 2006, with respect to the objection to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.

Applicant's arguments, filed 18 December 2006, with respect to the 35 USC 112 rejections of claims 1-14 have been fully considered and are persuasive. The 35 USC 112 rejections of claims 1-14 have been withdrawn.

Applicant's arguments filed 18 December 2006, with respect to the 35 USC 112 rejection of claim 16 have been fully considered but they are not persuasive. Though the applicant argues that the term "utilizing" is sufficient for indicating a method claim, claim 16 does not set forth any steps involved in the method and it is unclear what the method of claim 16 encompasses. Therefore, the rejection of the previous office action is maintained.

Applicant's arguments filed 18 December 2006, with respect to the 35 USC 103 rejections of claims 1-13 and 15-16 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, proper motivation and suggestion to combine the reference was given in the previous office action. The method of McCurdy was useful in making glass for architectural uses. Ganswein taught that by using gallium, the film is antireflective, which is a property useful for glass used in architecture. Therefore, one would want to use Gallium in the method of McCurdy to create an antireflective film on the architectural glass. In addition, US Patent 6328947 to Monden et al. shows that one would have a reasonable expectation of success when combining McCurdy and Ganswein as Monden et al. uses gallium chloride (column 2 lines 45-46) with an ester as an organic solvent and oxygen source (column 3 lines 27-30) to make gallium oxide. Thus, the 35 USC 103 rejections of the previous office action are maintained and are repeated here in their entirety.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 provides for the use of an inorganic gallium halide and an organic ester, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite

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where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent number 6238738 to McCurdy over US Patent number 5474851 to Ganswein.

Regarding claim 1, McCurdy discloses a chemical vapor deposition process for a metal oxide that includes preparing a precursor gas mixture containing a metal tetrachloride and an organic oxygen compound (preferably esters in column 4 line 42), maintaining the precursor gas mixture at a temperature below the metal halide will react to form an oxide while delivering the mixture to a coating chamber opening on to hot glass, and introducing the precursor gas mixture into the coating chamber whereby the mixture is heated to cause deposition of the metal oxide incorporating oxygen from the ester on the hot glass surface (column 4 lines 20-35). McCurdy does not disclose the metal as gallium, but does say that the invention is used to modify the characteristics of glass for architectural use (column 1 lines 26-28). Ganswein teaches that depositing gallium oxide using a metal precursor and oxygen source in vapor deposition produces a film that is antireflective on a glass substrate (column 1 lines 50-63). One of ordinary

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skill in the art would recognize that making a glass antireflective could be considered modifying the characteristics of glass for architectural use.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify McCurdy to include making a gallium oxide film by his method as taught by Ganswein in order to make a film that is antireflective on glass with a reasonable expectation that the method of McCurdy would be successful in depositing gallium oxide films.

Regarding claims 2 -4 and 10, McCurdy discloses the ester to be ethyl acetate and the substrate to be a float glass ribbon in column 4 lines 50-59.

Regarding claim 5, McCurdy discloses the metal precursor as a metal tetrachloride in column 4 lines 22-25, and one of ordinary skill would recognize it as a metal trichloride when gallium is the corresponding metal as taught by Ganswein discussed above.

Regarding claims 6-7, the flow rate of McCurdy is over 130 A/sec in column 5 lines 17-20.

Regarding claim 8, McCurdy discloses a laminar flow process in column 7 lines 52-61.

Regarding claims 9 and 11, the glass is at a temperature of 1170 °F/630 °C and the metal oxide is deposited over a silica layer in column 8 lines 20-24.

Regarding claims 12 and 13, McCurdy discloses the metal halide to be 0.7 % of the mixture and the ester concentration approximately three times that of the metal halide in column 8 lines 30-35.

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Regarding claim 15, McCurdy in view of Ganswein includes most of the provisions as discussed above. Additionally, McCurdy discloses the substrate temperature to be above the thermal decomposition temperature of the organic ester. Since the substrate is float glass, one of ordinary skill in the art would recognize that it must be coated at essentially atmospheric pressure, as a float glass production process cannot be performed in vacuum.

McCurdy in view of Ganswein includes all of the recitations of claim 16 as discussed above.

Allowable Subject Matter

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Ganswein does not include the refractive index of the gallium oxide film as claimed. Therefore Ganswein does not meet the recitations of 14.

Claim 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 18 is allowed, for the same reasons given above for claim 17.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Stouffer whose telephone number is (571) 272-2668. The examiner can normally be reached on Monday - Thursday 7:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Stouffer
Examiner
Art Unit 1762

kms



TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER